

REMARKS/ARGUMENTS

Examiner has rejected Claims 1-34 “under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Specifically, with “regards to claims 1, 26 and 30, it is unclear what is meant by ‘non-coaxial’...it is not clear as to what axes are non-coaxial,” and with regard to claim 34, the “limitation ‘at least one spool retaining member’ in line 8” has “insufficient antecedent basis.”

In response, Applicant has amended Independent Claims 1, 26 and 30 to clarify the nature of the non-coaxial relationship, wherein it is the winding axes of the retained bobbin and the retained spool that are non-coaxial. Independent Claims 26 and 30 have been amended to more succinctly describe the relationship of the winding axes, and Independent Claim 1 has been further amended to describe that the winding axes of the retained bobbin and retained spool are perpendicular. Additionally, Applicant has amended Claim 34 to replace the word “retaining” in “at least one spool retaining member” as referenced by Examiner with the word “receiving,” wherein proper antecedent basis is provided therefore.

Examiner has rejected Claims 1-5, 10, 11, 13-15, 17, 19-29, 34 and 35 “under 35 U.S.C. §102(b) as being anticipated by *Manning* (U.S. 3,854,673).” In response, Applicant has amended Independent Claims 1, 26 and 30, and respectfully traverses Examiner’s rejection. *Manning* (‘673) does teach a spool and bobbin receiving member, however, Applicant respectfully asserts that *Manning* (‘673) does not utilize, anticipate, teach or render

obvious a spool and bobbin receiving member wherein the bobbin receiving member has a winding axes that is perpendicular to the winding axes of the spool. As noted by Examiner it is "the radial axis of the bobbin receiving member" of *Manning* ('673) that is non-coaxial to "the winding axes of the spool receiving member." Thus, the necessarily concentric relationship of the spool receiving member and the bobbin receiving member of *Manning* ('673) is unlike that of Applicant's device, wherein the center of a bobbin held therein is NOT aligned with the center of the spool, but the center bore of a bobbin held within Applicant's device is instead positioned in a perpendicular relationship to the center bore of a retained spool. There is no provision or description of any possibility of such a relationship in *Manning* ('673). Further, Applicant's invention is distinguished because Applicant's device does not facilitate nor enable a concentric relationship between a spool and a bobbin.

Applicant has amended Independent Claim 1 to clarify and more succinctly define that Applicant's bobbin receiving member and spool receiving member are positioned in "a non-coaxial relationship relative to one another such that **the winding axes of the retained bobbin is perpendicular to the winding axes of the retained spool,**" Claim 26 to clarify and more succinctly define "a device having a first section for holding the spool and a second section for holding the bobbin in a manner **wherein the winding axes thereof are non-coaxial,**" and Claim 30 to clarify and more succinctly define that the winding axes of a plurality of bobbin holders is non-coaxially related to the winding axes of a plurality of spool holders. Because "[t]he elements must be arranged as required by the claim," *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990), because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference,” *Verdegaal Bros. V. Union Oil co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), because “the identical invention must be shown in as complete detail as is contained in the...claim,” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989), and because *Manning* (‘673) does not include nor arrange the elements as required in Applicant’s claims, Applicant believes that Applicant’s Independent Claims 1, 26 and 30, as amended, are distinguished over *Manning* (‘673).

Examiner has rejected Claims 6-9 “under 35 U.S.C. §103(a) as being unpatentable over *Manning* (‘673) in view of *Spencer* (U.S. 4,998,685);” Claims 12 and 16 “under 35 U.S.C. §103(a) as being unpatentable over *Manning* (‘673) in view of *Staufert* (U.S. 2,914,271);” Claim 18 “under 35 U.S.C. §103(a) as being unpatentable over *Manning* (‘673) in view of *Dougherty* (U.S. 897,822);” and Claims 30-33 “under 35 U.S.C. §103(a) as being unpatentable over *Manning* (‘673) in view of *Fridolph* (U.S. 3,284,025).” In response, as above, Applicant has amended independent Claims 1, 26, and 30, and respectfully traverses Examiner’s rejection.

None of the references teach or suggest a bobbin and spool holder wherein the winding axes of the bobbin and spool held therein are non-coaxially related. Further, none teach or suggest any such embodiment or feature. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art,” *In re Royka*, 490 F.2d 981 (CCPA 1974), thus, Applicant respectfully asserts that the amended Independent Claims 1, 26 and 30 are not obvious, and, further, because “[i]f an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious,”

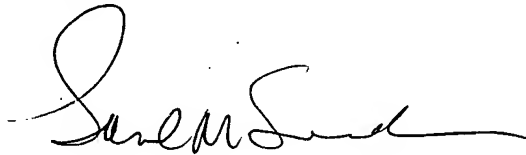
In re Fine, 837 F.2d 1071 (Fed. Cir. 1985), all remaining dependent Claims are also not obvious. Moreover, modifying *Manning* ('673), as suggested by Examiner, would change the principle of operation described, because it is a self-described focus of the design of the *Manning* ('673) device to enable that "the spool and the bobbin holder could be inserted over the spindle shaft of the sewing machine after the bobbin is removed from the holder...." See *Manning*, Col. 2, lines 44-47, thus necessitating a concentric relationship between the spool and bobbin holder. To modify *Manning* ('673) to be configured as Applicant's device would eliminate this principle of design and operation, wherein Applicant's device cannot facilitate a concentric relationship between the spool and bobbin holder. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Applicant believes that the foregoing amendments and arguments distinguish the claims over the prior art and establish that Applicant's claimed invention is novel and non-obvious, thereby placing the rejected independent claims 1, 26 and 30 and all remaining depending claims in condition for allowance.

CONCLUSION

The above-made amendments are to form only and thus, no new matter was added. Applicant respectfully believes that the above-made amendments now place the Claims and application in condition for allowance. Should the Examiner have any further questions and/or comments, Examiner is invited to telephone Applicant's undersigned Attorney at the number below.

Respectfully submitted, this 14th day of November, 2005,

A handwritten signature in black ink, appearing to read 'Sandra M. Sovinski', written over a horizontal line.

Sandra M. Sovinski, Esq.
Reg. No. 45,781
Email: ssovinski@mkiplaw.com

MYERS & KAPLAN,
INTELLECTUAL PROPERTY LAW, L.L.C.
1899 Powers Ferry Road
Suite 310
Atlanta, GA 30339
Phone: (770) 541-7444
Fax: (770) 541-7448